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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/468,002

12/20/1999

PAUL NEGULESCU

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3109

26191 7590 02/17/2005

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EXAMINER

LANDSMAN, ROBERT S

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/468,002

Applicant(s)

NEGULESCU ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 66-70, 74, 78, 80, 84-88, 93, 97-101, 105-132, 139-145 and 147-150 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 66-70, 74, 78, 80, 84-88, 93, 97-101, 105-132, 139-145 and 147-150 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/29/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***1. Formal Matters***

- A. The Amendment dated 11/29/04 has been entered into the record.
- B. Claims 66-70, 74, 78, 80, 84-88, 93, 97-101, 105-132, 139-145 and 147-150 are pending and are the subject of this Office Action.
- C. The Information Disclosure Statement dated 11/29/04 has been entered into the record.
- D. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

### ***2. Claim Objections***

- A. Claim 117 is objected to since it appears that it should depend from claim 116.

### ***3. Claim Rejections - 35 USC § 112, second paragraph***

- A. Claims 93, 97-101, 105-109, 116, 117, 124, 125, 128, 131, 132, 143-145, 149 and 150 remain rejected under 35 USC 112, second paragraph, for the reasons already of record on page 2 of the Office Action mailed 2/24/04. Applicants have amended claims 143-145 to omit the GPCR from control cells as done in claims 139-142. However, it is not understood why the conclusion steps for claims 143-145 refer to, for example in claim 143, "COS-7 cells comprising only (a) and (b)." It is believed that the control cells should not contain the GPCR and should recite, for example, "comprising only (a) and (c)." If the claims are not amended, an explanation is recommended. Claims 93, 97-101, 105-109, 116, 117, 124, 125, 128, 131, 132, 149 and 150 are rejected since they depend from rejected base claims.

- B. The rejection of claim 145 under 35 USC 112, second paragraph, has been withdrawn in view of Applicants' amendments to the claims.

#### **4. Double Patenting.**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

A. Claims 66-70, 74, 78, 80, 84-88, 93, 97-101, 105-132, 139-145 and 147-150 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,004,808. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present invention recite isolated cells which comprise all of the components of the methods claimed in the present invention. Furthermore, the cells of the patent are the same cells used in the methods of the present invention. Applicants present disclosure as well as that in the patent teach the use of these cells in screening methods to identify ligands for the transfected receptors, and vice versa. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the present invention to have used the cells comprising GPCR and second messenger systems to have used these cells to screen for ligands to these receptors, or for receptors for the ligands. There would have been a reasonable expectation of success since ligand screening methods using transfected cells were well-known in the art at the time of the present invention.

#### **5. Conclusion**

A. No claim is allowable.

Art Unit: 1647

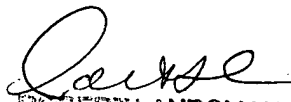
***Advisory information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on M-Th 9 AM-6 PM (eastern); alt F 9 AM-6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert Landsman  
Primary Examiner  
Art Unit 1647

  
ROBERT LANDSMAN  
PATENT EXAMINER